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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/575,124	05/23/2000	Kia Silverbrook	NPT003US	9151

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BALMAIN, 2041
AUSTRALIA

EXAMINER

FRANKLIN, JAMARA ALZAIDA

ART UNIT PAPER NUMBER

2876

DATE MAILED: 04/10/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/575,124

Applicant(s)

SILVERBROOK ET AL.

Examiner

Jamara A. Franklin

Art Unit

2876

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 February 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-113 is/are pending in the application.
- 4a) Of the above claim(s) 1-59 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 60-113 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

1. Claims 1-59 withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in Paper No. 5.

2. Applicant's election with traverse of method claims 60-113 in Paper No. 6 is acknowledged. The traversal is on the ground(s) that the process requires the step of defining coded data and it is submitted that any process for producing the product will require a step of defining coded data. This is not found persuasive because the examiner submits that the product as claimed in claim 1 can be made by another and materially different process than the one claimed in claim 60.

The requirement is still deemed proper and is therefore made FINAL.

Claim Objections

3. Claims 75, 79, and 90 are objected to because of the following informalities:

in claim 75, line 2, substitute "their" with --tag--,

in claim 79, line 1, insert --are-- between "tags" and "substantially", and

in claim 90, line 2, substitute "its" with --a--.

Appropriate correction is required.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 60, 61, 63, and 80 are rejected under 35 U.S.C. 102(b) as being anticipated by Lazzouni et al. (US 5,661,506) (cited by applicant and hereinafter referred to as 'Lazzouni').

Lazzouni teaches an encoded paper that is encoded with a pattern of pixels which contain absolute position information. The pixels include bit locations which are printed with infrared inks that are invisible to the human eye (col. 4, lines 15-21). In addition to X and Y coordinate information, the pixel 100 encodes pixel orientation information, and may include additional information (col. 7, lines 52-60).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out

the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

8. Claims 62, 64-79, 81-113 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lazzouni in view of Shamir (US 5,568,555). The teachings of Lazzouni have been discussed above.

Lazzouni lacks the teaching of coded data including at least one tag.

Shamir teaches a microlabel 40 having information encoded into a matrix and read out (col. 6, lines 50-54).

One of ordinary skill in the art would have readily recognized that coded data including at least one tag would have been advantageous since the tag could be moved about the surface onto which the tag is applied, thereby allowing for the convenient placement or movement of the tag upon the surface. Therefore, it would have been obvious, at the time the invention was made, to magnify the teachings of Lazzouni with the aforementioned teachings of Shamir.

Lazzouni/Shamir lack the teaching of the tags disposed in a triangular array and the relative spacing of the centers of the tags.

An arrangement of the tags of a specific size, shape, and dimensions is an aesthetic design variation or space consideration that was chosen as such for its appeal to the eye.

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to create an array of tags presented in a certain shape and a relative spacing of the tags in a particular arrangement as a design expedient.

Conclusion


9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Dymetman et al. (US 6,330,976) teach marking medium area with encoded identifier for producing action through network.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jamara A. Franklin whose telephone number is (703) 305-0128. The examiner can normally be reached on Monday through Friday 8:00am to 4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached on (703) 305-3503. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-7722 for regular communications and (703)308-7722 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.


Jamara A. Franklin
Examiner
Art Unit 2876

JAF
April 8, 2002


MICHAEL G. LEE
SUPERVISORY PATENT EXAMINER
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